In re Application of:
David L. Franklin, et al. Serial No. 10/734,468

REMARKS

As an initial note, the Applicants thank the Examiner for allowing Claims 4 and 5 and acknowledging that Claims 14 and 15 include allowable subject matter. Applicants' representative also thanks the Examiner for the courtesies extended during the recent Examiner interview on June 15, 2005. The Applicants have amended Claims 1, 11, 21, 22, 23, 26, 28, 29, and 30 without prejudice as to patentability including the doctrine of equivalents. The Applicants have also amended Claim 4 to correct a typographical error. Accordingly, Applicants respectfully submit that Claims 1-30 are in condition for allowance. The Applicants also submit that these minor amendments and corrections herein are made without prejudice, were not necessary to overcome the cited references, and that no new matter has been added.

Claims 11-20 and 26-30 Satisfy 35 U.S.C. § 112, Second Paragraph.

The Examiner rejected Claims 11-20 and 26-30 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, asserting that the use of "adapted to" language in the preamble of Claims 11, 26, 28, and 29 "suggests that only 'an operation counter assembly' is being positively claimed and the 'circuit interrupting assembly' is not being positively claimed." Although Applicants believe this issue was properly addressed in the prior Office Action Response (dated January 17, 2005), because this present Office Action (dated March 7, 2005) did not address the Applicants' assertion, the Applicants respectfully resubmit that the Examiner is correct in understanding that Claims 11-20 and 26-30 are positively claiming "an operational counter assembly" and that the "circuit interrupting assembly" is not being positively claimed in these claims. Limitations such as "an operational counter assembly *adapted to* be positioned on a circuit interrupting apparatus" as used in the aforementioned claims serve to precisely define the structural attributes of interrelated component parts according to the embodiments of the present invention as claimed in the aforementioned claims. *See* MPEP 2173.05(g) (stating that "limitations such as 'members *adapted to* be positioned' serve to precisely define present structural attributes of interrelated component parts of the claimed assembly" (emphasis added)) (internal citations omitted).

Further, the originally filed written description and/or figures provide sufficient support for the subject claims. For example, Application para. [0007] identifies a need for an operational counter that can be easily and inexpensively retrofitted to existing circuit interrupting apparatus to provide a count of the number of operations performed by the operator. Application para. [0009] states that embodiments of the present invention provide a counter and methods. Application para. [00029] identifies that inclusion of the operations counter assembly to form the circuit interrupting apparatus 32 is an improvement upon the circuit interrupting apparatus described in U.S. Patent No. 5,861,595 by Wood et al. (incorporated by reference), cited by the Examiner, and further identifies that the operation counter 91 of embodiments of the present invention can be retrofitted to other circuit interrupting apparatus.

The Applicants, in order to expedite issuance of a notice of allowability, have nevertheless amended Claims 11, 26, 28, and 29 to remove the word "adapted."

Claims 1-3, 6-13, and 16-28 are not Obvious.

The Examiner rejected Claims 1-3, 6-13, and 16-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,861,595 by Wood et al. in view of U.S. Patent No. 6,300,585 by Nicolai et al. The Applicants respectfully traverse the rejection.

Nicolai et al. describes an operational counter arrangement 10 used to count the number of operations of a load brake tool 18 having: an exhaust control assembly 20; and a trailer portion 14 made of arc-extinguishing material which protrudes into the exhaust control assembly 20. *See* Nicolai et al., col. 3, lines 24-39 and FIGS. 1-3. The operation counter arrangement 10 is disclosed as being either affixed to the load brake tool 18 by "incorporate[ing the arrangement 10] into the *exhaust control assembly* 20 or via the assembl[ing] . . . the operational counter arrangement 10 into the existing *exhaust control device* 20 as illustrated" in FIGS. 1-3. *See also* col. 3, lines 39-43. Movement of the trailer portion 14 causes movement of actuator 30, which engages an operational counter switch 34. *See* FIGS. 1-3 and col. 3, lines 44-46.

To establish a *prima facie* case of obviousness, MPEP 2143 describes three basic criteria that must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references, when combined, must teach or suggest all the claim limitations.

More particularly, the prior art must provide a motivation or reason for a worker in the art, without the benefit of Applicants' specification, to make the changes in the reference device." *See, e.g.*, MPEP 2144.04 (citations omitted). Though there may be motivation provided by Nicolai et al. to connect an operational counter to an exhaust control device of a circuit interrupting apparatus or incorporate an operational counter into an exhaust control assembly of such circuit interrupting apparatus, there is *no* motivation in Nicolai et al. to provide a structural arrangement whereby an operational counter assembly including an operations counter is positioned at a medial portion of a main housing body of the apparatus and connected to or interfaced with a reset plunger or a reset plunger assembly associated with the medial portion of the main housing body of the apparatus, as featured in independent Claims 1, 11, 23, and 29, or whereby an operational counter is positioned at a medial portion of the main body of the apparatus separate and spaced apart from the exhaust control assembly, as featured in independent Claims 21, 22, 26 and 28.

As stated in the background section of the application (para. [0007]), Applicants recognized that counters such as that disclosed by Nicolai et al. are prone to excessive wear because part of the counter mechanism is in contact with arc-interrupting components or shunt interrupting circuits which are subject to the wear and tear or other forms of degradation caused by arcing resulting from the circuit interrupting operation. As such, the Applicants recognized a need for an interrupting apparatus which can count the number of operations performed by each circuit interrupting apparatus and that does *not* require direct interface with interrupting circuit components such as exhaust control assembly 20 and trailer portion 14. There is no motivation except in the present Application's specification to make such structural arrangement. The proposed combination of Nicolai et al. and Wood et al. would not result in the Applicants' invention because it would not provide either a portable circuit interrupting apparatus as featured/described in Claims 1, 21, 22, or 23, or an operational counter assembly as featured in Claims 11, 26, 28, or 29, but would instead only provide the modified load brake tool 18 described in Nicolai et al.

More specifically, the combination of Nicolai et al. and Wood et al. does not teach or suggest the claimed structures. For example, with respect to Claims 1, 11, 21, 22, 23, 26, 28, and 29, Nicolai et al. fails to disclose, teach, or suggest an operation counter positioned at a medial portion of the main housing body of a circuit interrupting apparatus. Nicolai et al. also fails to disclose, teach, or suggest such an operational counter connected to or associated with a "reset plunger" or "reset plunger assembly" associated with the medial portion of a main housing body of the apparatus. With respect to Claim 22, Nicolai et al. further fails to disclose, teach, or suggest an operation counter incremented directly in response to either extension or retraction of a reset plunger through a reset plunger opening extending through the medial portion of the main sleeve body.

Nothing in the Nicolai et al. structure of either actuator 30 or extension 32 implies that such components "reset" the load break tool 18, and thus, cannot be considered a reset plunger. Nor are they structurally positioned through a medial portion of the main body. The Application describes a reset plunger (76) as a device that is structurally configured to releasably lock sleeve (36) in its extended position until manually released by user manipulation of the reset plunger (76). *See* Application para. [0038] and FIGS. 4-6. On page 4, last paragraph, of the present Office Action, the Examiner identified an assembly illustrated in Wood et al., FIG. 3, item [76] as the reset plunger assembly described in the claims. Although the [76] in the FIG. 3 is actually only pointing to a "release pin," and not an entire release assembly, the Applicants agree with the Examiner that on this particular circuit interrupting apparatus illustrated in Wood et al., this release assembly is a functional equivalent of the described "reset plunger" prior to retrofitting with the claimed operational counter.

The actuator 30 and extension 32 described in Nicolai et al. are not equivalents of or in any way related to this "reset plunger assembly [76]" identified by the Examiner. In fact, they are just extensions of the Nicolai et al. operational counter switch mechanism interfaced with an exhaust control assembly 20 positioned on a distal end of a load break tool 18. *See* Nicolai et al., FIGS. 1-3. As such, Nicolai et al. does not disclose, teach, or suggest an operational counter 10 to be connected to or interfaced with such type of reset pin [76] or component having a similar structure or function thereof. Thus, the cited patents do not disclose, teach, or suggest an operation counter

connected to, interfaced with, or directly actuated by a "reset plunger" of a circuit interrupting apparatus.

Further, with respect to Claims 21, 22, 26 and 28, Nicolai et al. fails to disclose, teach, or suggest an operational counter positioned at a medial portion of the main housing body of a circuit interrupting apparatus *separate and spaced apart from an exhaust control assembly* of the circuit interrupting apparatus. Nicolai et al. instead discloses an operation counter arrangement 10 incorporated into an exhaust control assembly 20 or assembled into an existing exhaust control device 20 as illustrated in FIGS. 1-3. *See* col. 3, lines 39-43. Further, with respect to Claim 28, the aforementioned exhaust control assembly 20 is threaded to a distal body end portion of the load brake tool 18 rather than a medial body portion. *See* col. 3, lines 36-44. Having a counter (actuation plunger) positioned as claimed rather than positioned on the distal body end portion of a circuit interrupting apparatus is an important feature because a counter (including actuator) located on the distal body end portion is more likely to count inadvertent extensions resulting in less accurate usage documentation, incorrect maintenance scheduling, and possibly premature retirement of the circuit interrupting apparatus.

Correspondingly, the independent Claims 1, 11, 21, 22, 23, 26, 28, and 29, and all corresponding dependent claims should be held allowable. The Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the above-described claims.

Still further, the dependent claims have independent novelty. For example, neither Nicolai et al. nor Wood et al. disclose, teach, or suggest: a roll pin connected to a reset plunger which engages a click-over lever, as featured in Claims 2 and 12; means for engaging a counter incrementor switch that is responsive to movement of a reset plunger in a longitudinal direction, as featured in Claims 3, and 13, or one having a plurality of amperage range categories, as featured in Claims 6 and 16; a reset plunger extension, as featured in Claims 7, 17, and 25; an operation counter housing front opening allowing passage of the reset plunger through an operational counter housing, as featured in Claims 8, 18, and 25; an operational counter that is non-resettable by a field operator, as featured in Claims 9 and 19; a fastener to fasten the operation counter housing to a medial portion of the main housing body of the circuit interrupting apparatus, as featured in Claims 10 and 20; or a counter incrementor switch positioned to increment a count of the operation counter

responsive to extension of at least portions of a reset plunger through an opening in the main sleeve body, as featured in Claims 24, 27, and 30. These structural differences were identified in the prior Office Action Response, but not addressed in the present Office Action.

Claim 21, 29, and 30 are not Anticipated.

The Examiner also rejected Claims 21, 29, and 30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,300,585 by Nicolai et al. The Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, whereby the identical invention must be shown in as complete detail as is contained in the claim. Nicolai et al. does not set forth each and every element featured in Claims 21, 29, or 30. Please note, Claims 29 and 30 are directed to an operational counter assembly.

For example, regarding Claims 21 and 29, Nicolai et al. fails to disclose, teach, or suggest an operational counter positioned at a medial portion of the main housing body of a circuit interrupting apparatus, as described above. Further, regarding Claim 21, Nicolai et al. fails to disclose, teach, or suggest an operational counter positioned *separate and spaced apart from an exhaust control assembly* of the circuit interrupting apparatus, nor an operational counter having an operational counter housing *front side opening* for allowing passage of a reset plunger through the operation counter housing and an operational counter having an operational counter housing backside opening adapted to interface with a reset plunger protruding through a main housing body outer surface. Although the Examiner states in section 4, page 3 of the present Office Action that Nicolai et al. discloses an "operation counter housing front side opening for allowing passage of [a] reset plunger through the operation counter housing," no such front side opening in the operational counter housing is shown or disclosed. Further, Nicolai et al. does not disclose, teach, or suggest fastening an operational counter housing to a *medial* body portion of a main body housing of the load break tool 18 (FIG. 1). Referring to Nicolai et al. FIG. 1, the Nicolai et al. operation counter arrangement 10 is instead fastened to an exhaust control assembly 20 located on a distal end portion. Still further, regarding Claims 21 and 29, as described previously, the Application

describes a reset plunger (76) as a device that is structurally configured to releasably lock sleeve (36) in its extended position until manually released by user manipulation of the reset plunger (76). *See* Application para. [0038]. The operational counter described in Nicolai et al. does not interface with such type of plunger. Regarding Claim 30, Nicolai et al. fails to disclose, teach, or suggest an operational counter adapted to reset for a next count, responsive to manual extraction of the reset plunger from the opening in the main sleeve body by a user.

Please note, in commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions or making any amendments herein to create any implied limitations in the claims. Not all of the distinctions between the prior art and Applicants' present invention have been made by Applicants. For the foregoing reasons, the Applicants reserve the right to submit additional evidence showing the distinctions between Applicants' invention to be novel and nonobvious in view of the prior art.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention that render it patentable, being only examples of certain advantageous features and differences which Applicants' attorney chooses to mention at this time.

In re Application of:
David L. Franklin, et al.

Serial No. 10/734,468

CONCLUSION

In view of the amendments and remarks set forth herein, Applicants respectfully submit that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowability in due course is respectfully requested.

Respectfully submitted,

Date: 6-21-05

Jeffrey S. Whittle
Reg. No. 36,382
BRACEWELL & GIULIANI LLP
P.O. Box 61389
Houston, Texas 77208-1389
Telephone: (713) 221-1185
Facsimile (713) 221-2141

1857483.1